

REMARKS

This responds to the Office Action mailed on February 2, 2006.

Claims 1-10 and 12-27 are now pending in this application.

Applicant notes that no formal rejections are proffered in this Final Office Action. Therefore, Final Rejection status is improper and should be withdrawn. Because the Office Action Summary cites claims 10 and 12-27 as being rejected, however, Applicant will address these claims.

1. Claims 10-21 and 24-25 were previously rejected under 35 U.S.C. § 103(a) as being unpatentable over Shanton (U.S. 5,776,619) in view of Nelli. Applicant respectfully traverses the rejection and requests the Office to consider the following.

The Office asserts that “Shanton is the primary reference”. (Final Office Action at page 3). The order of references asserted is immaterial.

A previous Office Action admitted that Shanton “fails to teach that the calcium carbonate in a first amount in the brightener first film, is more than the brightener particles in a second amount in the first brightener film” (Office Action at page 6). The previous Office Action also asserted that combination of Nelli with Shanton, would have been obvious to one of ordinary skill in the art. The Final Office Action refers to Nelli’s film (Nelli at column 2 lines 35-40) as “a “first film”.

But Nelli teaches only one film, and Nelli would not look to Shanton for a second film. Consequently, the combination of Nelli with Shanton can only be reached by using Applicant’s disclosure as a guide.

Thus, the only “first film” element that is taught by combination of references is Shanton’s “preferred base coat (‘first film’) mixture”. As previously asserted by Applicant, Shanton teaches that his “*preferred* base coat pigment mixture is 80 parts kaolin clay and 20 parts calcium carbonate” (Shanton at column 4, lines 43-45, emphasis added), *i.e.*, that the

calcium carbonate in a first amount in the brightener first film is *less* than the brightener particles in a second amount in the first brightener film. Thus, Shanton teaches away from what is claimed as preferred. Nelli also teaches away from what is claimed because Nelli teaches a single coat. Thus the combination of Shanton with Nelli cannot be reached without using Applicant's disclosure as a guide. Withdrawal of the rejections is respectfully requested.

2. The Final Office Action also asserted that "although the foregoing pigments [of Shanton] are preferred as components ... other pigments could be used." (Final Office Action at p age 4). But Shanton gives no amounts or ratios for the list of pigments beginning at column 5, line 66. Thus, Shanton neither prefers this list nor teaches amounts or ratios to use. Consequently, this is a non-enabling teaching by Shanton, which is further weakened by Shanton's preferred teaching. Withdrawal of the rejections is respectfully requested.

The previous Office Action also admitted that Shanton "fails to teach ... that a finish third film is provided above the brightener second film." (Office Action at page 6). Applicant agrees. The Office further asserted, by contradiction, *supra*, that "Shanton teaches that [etc.] are used as film formers ... and varnishes" Applicant respectfully asserts that none of these substances are taught in connection with a "finish third film" (Claim 10), rather, only in connection with Shanton's "base or top coat" (Shanton at column 5, line 28) and as otherwise described with Shanton's, *e.g.*, "preferred acrylate-styrene-acrylonitrile polymer with a 90/10 or 80/20 blend of kaolin to calcium carbonate clearly demonstrate higher gloss varnish" (Shanton at column 7, lines 30-34). Thus the admission of the Office is correct and Shanton does not teach a finish third film as claimed. The Office Action adds nothing from Nelli to remedy this deficiency. Because all the claim limitations are not taught by the cited references, alone or in combination, withdrawal of the rejections is respectfully requested.

Because claims 11-21 depend from claim 10 and because a *prima facie* case of obviousness has not been established for claim 10, withdrawal of rejection of claims 11-21 is also requested, discounting withdrawal of rejection of the canceled claim 11.

Regarding claims 12-13, because the combination of Shanton with Nelli does not teach all the limitations of these claims as admitted by the Office with respect to claim 10, withdrawal of the rejection is respectfully requested.

Regarding claim 14, because the combination of Shanton with Nelli does not teach all the limitations of these claims as admitted by the Office with respect to claim 10, withdrawal of the rejection is respectfully requested.

Regarding claim 15, because the combination of Shanton with Nelli does not teach all the limitations of these claims as admitted by the Office with respect to claim 10, withdrawal of the rejection is respectfully requested.

Regarding claims 16-17, the Office Action admits that “Shanton in view of Nelli fails to disclose that the polyvinylacetate latex and SBR latex are in a ratio of about 10:9” The Office Action asserts that one can reach the limitations of claims 16-17 by use of Shanton and Nelli. But as set forth above, because the combination of Shanton with Nelli does not teach all the limitations of these claims as admitted by the Office with respect to claim 10, withdrawal of the rejection is respectfully requested.

Regarding claim 18, because the combination of Shanton with Nelli does not teach all the limitations of these claims as admitted by the Office with respect to claim 10, withdrawal of the rejection is respectfully requested.

Regarding claims 19-20, the Office Action admits that “Shanton in view of Nelli fails to disclose that the polyvinylacetate latex and SBR latex are in a ratio of about 1:1” The Office Action asserts that one can reach the limitations of claims 19-20 by use of Shanton and Nelli. But as set forth above, because the combination of Shanton with Nelli does not teach all the limitations of these claims as admitted by the Office with respect to claim 10, withdrawal of the rejection is respectfully requested.

Regarding claims 24-25, the Office Action uses the same mechanism to reject these claims as the rejection of claim 10. Because the Office has second admitted, however, that Shanton “fails to teach ... that a finish third film is provided above the brightener second film” (Office Action at page 6), and because as asserted above, neither does the Office invoke Nelli to remedy this deficiency, withdrawal of the rejection is respectfully requested.

3. Claims 22-23 and 26-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shanton in view of Nelli as applied to claims 10-21 and 24-25 above, and further in view of Kinsey (U.S. 6,110,548). Applicant respectfully traverses the rejection and requests the Office to consider the following.

The Final Office Action did nothing to rebut Applicant's traversal. The Office has the burden of coming forward with a rebuttal.

Kinsey adds nothing to remedy the deficiencies of Shanton in View of Nelli with respect to the limitations of the brightener first film and the finish third film of claim 10. Although Kinsey may teach a gable (claim 22), the combination of Shanton in view of Nelli and Kinsey does not teach the limitations of the brightener first film and the finish third film. Withdrawal of the rejections is respectfully requested. Although Kinsey may teach a skived gable with an inner surface (claim 23), the combination of Shanton in view of Nelli and Kinsey does not teach the limitations of the brightener first film and the finish third film. Withdrawal of the rejections is respectfully requested. Although Kinsey may teach a gable (claim 26), the combination of Shanton in view of Nelli and Kinsey does not teach the limitations of the brightener first film and the finish third film. Withdrawal of the rejections is respectfully requested. Although Kinsey may teach a skived edge (claim 27), the combination of Shanton in view of Nelli and Kinsey does not teach the limitations of the brightener first film and the finish third film. Withdrawal of the rejections is respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (801) 278-9171 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,


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By their Representatives,

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Date 2 JUNE 2006


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 2 day of June, 2006.

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Signature